



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/677,172

10/02/2003

Serkan Savasoglu

030586

8324

26285 7590 09/27/2007
KIRKPATRICK & LOCKHART PRESTON GATES ELLIS LLP
535 SMITHFIELD STREET
PITTSBURGH, PA 15222

EXAMINER

SHAIKH, MOHAMMAD Z

ART UNIT

PAPER NUMBER

3609

MAIL DATE

DELIVERY MODE

09/27/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/677,172

Applicant(s)

SAVASOGLU ET AL.

Examiner

Mohammad Z. Shaikh

Art Unit

3609

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 02/25/04, 08/14/07.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections- 35 USC§102

1. The following is a quotation of 35 U.S.C 102(b) which forms the basis for a prior art rejection set forth in this office action:
 - (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States:
2. Claims 1,3,6-9,12-13,15,18-20,24-25 are rejected under 35 U.S.C 102(b) as being anticipated by U.S Patent 6,263,321 to Daughtery,III herein referred to as Daughtery.

Regarding claim 1, Daughtery discloses a unit comprising:

forward contract and a remarketable security that secures performance of obligations of the forward contract, the forward contract requiring a holder to purchase a quantity of common stock from an issuer at a settlement price on or before a settlement date, the remarketable security having an issue denomination and a maturity date later than the settlement date (column 21, lines 33-39).

Wherein the unit provides, at time of issue, that the remarketable security is to be offered to new holders at a remarketing time (column 22, lines 60-63) and at least one of:

The remarketable security is to be offered at a remarketing rate different from the issue denomination (column 2, lines 44-45).

Art Unit: 3609

The remarketable security is to be offered with a remarketing coupon frequency different from and issue coupon frequency and the remarketable security is to be offered without a previously available interest rate deferral option to the issuer (column 2, lines 34-35).

Regarding claims 3&7, Daughtery teaches the unit of claim 1, wherein the unit provides, at time of issue, that the issuer has a unilateral right to change the maturity date of the remarketable security on the remarketing dates (Column 23, lines 4-5).

Regarding claim 6, Daughtery teaches the unit of claim 1, wherein the forward contract and the remarketable security are separable (Column 21, lines 33-37).

Regarding claim 8, Daughtery teaches the unit of claim 1, wherein the issuer cannot optionally redeem the remarketable security (Column 22, lines 60-63).

Regarding claim 9, Daughtery teaches the unit of claim 1, wherein the remarketable security cannot be paid in or converted into stock of the issuer (column 23, lines 13-15).

Regarding claim 12, Daughtery discloses the unit of claim 1, wherein the given quantity of stock is determined by a formula based on price of the stock at expiration the forward contract (column 21, lines 34-36).

Regarding claim 13, Daughtery discloses a method comprising the steps of:

Issuing a unit to a holder, the unit comprising a forward contract and a remarketable security that secures performance of obligations of the forward contract, the forward contract requiring the holder to purchase of a quantity of stock from an issuer at a settlement price on or before a settlement date, the remarketable security having an

Art Unit: 3609

issue denomination and a maturity date later than the settlement date (column 21, lines 34-39); and at least one of:

Offering, at a remarketing time, the remarketable security to one or more new investors at a remarketing denomination different from the issue denomination, wherein the unit provides the remarketing denomination at time of issue (column 22, lines 60-63).

Offering, at a remarketing time, the remarketable security to one or more new investors at a remarketing coupon frequency different from an issue coupon frequency, wherein the unit provides the remarketing coupon frequency at time of issue and offering, at a remarketing time, the remarketable security to one or more new investors without a previously available interest rate deferral option to the issuer (column 23, lines 4-5).

Regarding claim 15, Daughtery discloses the method of claim 13, further comprising the step of: changing the maturity date of the remarketable security on the remarketing date (column 22, lines 52-54).

Regarding claim 18, Daughtery discloses the method of claim 13, further comprising the steps of selling the remarketable security to a new investor; and satisfying the forward contract with proceeds obtained from the new investor (column 21, lines 33-37).

Regarding claim 19, Daughtery discloses the method of claim 13, further comprising the step of delivering a quantity of stock to the holder (column 21, lines 34-36).

Art Unit: 3609

Regarding claim 20, Daughtery discloses the method of claim 19, wherein the quantity of stock is determined by a formula based on price of the stock at expiration the forward contract payoff function (column 21, lines 34-36).

Regarding claim 24, Daughtery discloses the method of claim 13, wherein the remarketing time comprises one or more remarketing dates (column 22, lines 52-54).

Regarding claim 25, Daughtery discloses the a computer system (Abstract, lines 1-3) comprising: an issuing agent for issuing a unit to a holder, the unit comprising a forward contract and a remarketable security that secures performance of obligations of the forward contract, the forward contract requiring the holder to purchase a quantity of stock from an issuer at a settlement price on or before a settlement date, the remarketable security having an issue denomination and a maturity date later than the settlement date (column 21, lines 33-39); and

A remarketing agent for performing at least one of offering, at a remarketing time, the remarketable security to one or more new investors at a remarketing denomination different from the issue denomination, wherein the unit provides the remarketing denomination at time of issue (column 22, lines 60-63); Offering, at a remarketing time, the remarketable security to one or more new investors at a remarketing coupon frequency different from an issue coupon frequency, wherein the unit provides the remarketing coupon frequency at time of issue and offering, at a remarketing time, the remarketable security to one or more new investors without a previously available interest rate deferral option to the issuer (column 2, lines 34-35).

Claim Rejections- 35 USC § 103

The following is quotation of 35 U.S.C 103(a) which forms the basis for all obviousness rejections set forth in this action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2,14,16 are being rejected under 35 U.S.C 103(a) as being unpatentable over Daughtery in view of US 2004/0193536A1 to Marlowe-Noren.

Regarding claim 2, Daughtery teaches the unit of claim 1. However Daughtery does not specifically disclose the unit of claim 1 wherein the unit provides, at time of issue, that the remarketable security is to be remarketed without subordination to senior debt of the issuer. Marlowe-Noren does teach wherein the unit provides, at time of issue, that the remarketable security is to be remarketed without subordination to senior debt of the issuer (page 7, paragraph 54). Therefore it would have obvious to one ordinary skill in the art at the time the invention was made to modify Daughtery's invention to include a feature where the unit provides, at time of issue, that the remarketable security is to be remarketed without subordination to senior debt of the issuer.

Regarding claim 4, Daughtery does disclose the unit of claim 1. However Daughtery does not specifically disclose wherein the unit provides, at time of issue, that the issuer has a unilateral right to add one or more financial covenants on the remarketing date. Marlowe-Noren does teach the unit of claim 1, wherein the unit

Art Unit: 3609

provides, at time of issue, that the issuer has a unilateral right to add one or more financial covenants on the remarketing date (page 13:136-137). Therefore it would have been obvious to one of skill in the art at the time of the invention to modify Daughtery's invention to include a feature where the unit provides, at time of issue, that the issuer has a unilateral right to add one or more financial covenants on the remarketing date.

Regarding claim 14, Daughtery does disclose the method of claim 13. However Daughtery does not specifically teach the method of claim 13, further comprising the step of: offering, at a remarketing time, the remarketable security to one or more new investors without subordination to senior debt of the issuer. Marlowe-Noren does teach the method of claim 13, further comprising the step of: offering, at a remarketing time, the remarketable security to one or more new investors without subordination to senior debt of the issuer (page 7, paragraph 54). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Daughtery's invention to include a feature to offer at a remarketing time, the remarketable security to one or more new investors without subordination to senior debt of the issuer.

Regarding claim 16, Daughtery does disclose the method of claim 13. However Daughtery does not specifically teach the method of claim 13, further comprising the step of: "adding one or more financial covenants on the remarketing date. Marlow-Noren does teach the method of claim 13, further comprising the step of: "adding one or more financial covenants on the remarketing date (page 13:136-137). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to

Art Unit: 3609

modify Daughtery's invention to include the step of adding one or more financial covenants on the remarketing date.

4. Claims 5,17 are rejected under 35 U.S.C 103(a) as being unpatentable over Daughtery in view of US 2003/0130941A1 to Birle, JR et al, herein referred to as Birle.

Regarding claim 5, Daughtery does disclose the unit of claim 1. However Daughtery does not specifically disclose the unit of claim 1, wherein the unit provides, at time of issue, that the issuer has a unilateral right to make the remarketable security callable after the remarketing date. Birle does teach the unit of claim 1, wherein the unit provides, at time of issue, that the issuer has a unilateral right to make the remarketable security callable after the remarketing date (paragraph 39, lines 1-21). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Daughtery's invention to include a feature where the unit provides, at time of issue, that the issuer has a unilateral right to make the remarketable security callable after the remarketing date.

Regarding claim 17, Daughtery does disclose the method of claim 13. However Daughtery does not specifically disclose the method of claim 13, further comprising the step of." making the remarketable security callable after the remarketing date. Birle does teach the method of claim 13, further comprising the step of." making the remarketable security callable after the remarketing date (paragraph 39, lines 1-21). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Daughtery's invention to include a step of making the remarketable security callable after the remarketing date.

Art Unit: 3609

5. Claims 10-11 are being rejected under 35 USC 103(a) as being unpatentable over Daughtery in view of U.S. Patent 7,236,955 to Sugahara.

Regarding claims 10&11, Daughtery discloses the unit of claim 1. However Daughtery does not disclose the unit of claim 1, wherein the remarketable security comprises a debt security and a preferred security. Sugahara however does teach the unit of claim 1, wherein the remarketable security comprises a debt security and a preferred security (column 4, lines 16-19). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Daughtery's invention to include a feature where the remarketable security comprises a debt security and a preferred security.

6. Claims 21-23 are being rejected under 35 USC 103 as being unpatentable over Daughtery in view of US 2002/0103852A1 to Pushka.

Regarding claim 21, Daughtery discloses the method of claim 13. However Daughtery does not specifically disclose the method of claim 13, further comprising the step of collecting a remarketing fee. Pushka does teach the method of claim 13, further comprising the step of collecting a remarketing fee (paragraph 125, "The counterparty...portfolio). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Daughtery's invention to include the step of collecting a remarketing fee.

Regarding claims 22&23, Daughtery discloses the method of claim 13. However Daughtery does not specifically disclose the method of claim 13, wherein the

Art Unit: 3609

remarketable security comprises a debt and preferred security. Sugahara however does teach the unit of claim 1, wherein the remarkable security comprises a debt security and a preferred security (column 4, lines 16-19). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Daughtery's invention to include a remarkable security that comprises a debt security and a preferred security.

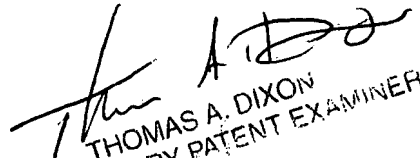
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad Z. Shaikh whose telephone number is (571)270-03444. The examiner can normally be reached on Monday-Friday (7:30-5); alt Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dixon can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3609

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mohammad Z Shaikh
Examiner
Art Unit 3609


THOMAS A. DIXON
SUPERVISORY PATENT EXAMINER